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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,211	04/04/2005	Arnold Keller	246472007600	9918
25227 7590 08/04/2009 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
GANESAN, SUBA				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
08/04/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/530,211

**Applicant(s)**

KELLER, ARNOLD

**Examiner**

SUBA GANESAN

**Art Unit**

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 4/22/2009 have been fully considered but they are not persuasive. Applicant argues that it would not be obvious that the fins extend rectilinearly at an angle of 5-15 degrees with respect to the longitudinal axis of the shaft because Niederer discloses that the fins extend "at least approximately in the direction of the neck 6" for the purpose of preventing the bone shank from sinking into the bone cement.
2. Examiner disagrees. The language "at least approximately in the direction of the neck" is sufficiently broad to encompass a range of 5-15 degrees. "At least approximately" implies that the fin can be slightly biased towards the neck; Examiner contends that this statement from Niederer is NOT evidence in favor of only large angles (such as the approximately 50 degree angle shown in the figures of Niederer), but is rather a broad suggestion to an ordinary practitioner in the art.
3. There is no evidence that an angle of 5-15 degrees would lead to the bone shank to sink into the bone cement. Thus there is no teaching away for such a modification, and such a modification would not render the prosthesis unsatisfactory for its intended use. Additionally, one of ordinary skill in the art would be motivated to provide an angle of 5-15 degrees for other reasons, such as ease of insertion into a prepared bone, amount of material used, bone purchase at the implantation site, etc. The level of ordinary skill in the art of hip prosthesis design and use is high, and thus the specific

angle of the angled fin of Niederer would have been readily apparent and obvious in view of numerous design considerations for hip prosthesis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-2, 4-5, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niederer (U.S. Pat. No.: 4,359,785).
2. Niederer discloses a hip prosthesis comprising a shaft and a femoral neck, the shaft having a proximal part comprising projecting fins **12** on the front and rear faces of the proximal part (see figs. 1-3). Each fin **12** extends from a distal end of the proximal part to a proximal end of the proximal part (see fig. 2) and has a steep medial flank (see fig. 3), each fin having a surface portion delimited by a medial edge and a lateral edge, the medial edge forming a borderline between the surface portion and the steep flank. The width of the fin increases from the distal end to the proximal end of the proximal part (see fig. 1), and the height of the fins decreases in a lateral direction from an edge delimiting the steep flank (see fig. 3). The prosthesis comprises a device **2** for anchoring the endoprosthesis to a diaphysis. However, Niederer fails to show the angle of the angled fin. However, it would have been an obvious matter of design choices to have a fin angle of 5 to 15 degrees, since such a modification (if any) would have involved a

mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Examiner considers this feature to be an obvious design choice that would be considered when designing for ease of insertion into a prepared bone, amount of material used, bone purchase at the implantation site, etc. The level of ordinary skill in the art of hip prosthesis design and use is high, and thus the specific angle of the angled fin of Niederer would have been readily apparent and obvious in view of numerous design considerations for hip prosthesis.

3. With respect to claims 4 and 8, Niederer fails to specify whether the height of the lateral edge of the fin is not greater than half the height of the medial edge (See fig. 3). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a lateral edge fin height that is not greater than half the height of the medial edge, since it has been held that where the general conditions of a claims are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

4. Claims 3, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niederer (U.S. Pat. No.: 4,359,785) in view of Tanamal et al (U.S. Pat. No.: 5,755,811).

5. Niederer is explained supra. However, Niederer fails to show the height of the fin above the surface of the shaft increasing from the distal end to the proximal end of the proximal part. Tanamal teaches the use of tapered fins (see fig. 3) resulting in a

prosthetic with improved rotational stability (col. 3 lines 32-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the finned prosthesis as disclosed by Niederer with a taper towards the distal end of the prosthesis as taught by Tanamal for the purpose of facilitating easier insertion of the finned prosthesis.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUBA GANESAN whose telephone number is (571)272-3243. The examiner can normally be reached on M-F 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. G./  
Examiner, Art Unit 3774  
/William H. Matthews/  
Primary Examiner, Art Unit 3774